

REMARKS

Prior to the instant response, claims 35, 40-41, 54-55, 64, 66, and 68-80 were pending in the application. By amendment herein, claims 68-72 have been cancelled. Thus, claims 35, 40-41, 54-55, 64, 66, and 73-80 are now pending.

I. Claim Rejections - 35 U.S.C. § 112

In the Office Action, the Examiner has rejected claim 68 under 35 U.S.C. § 112 as being indefinite. This claim has been cancelled. Therefore, it is respectfully requested that this rejection be withdrawn.

II. Claim Rejections Under 35 U.S.C. 103

In the Office Action, the Examiner has rejected the pending claims as being unpatentable over Eggensperger et al., i.e., U.S. Patent No. 5,276,047, in view of Ofusu-Asante et al., i.e., U.S. Patent No. 6,387,856. It appears that it is the Examiner's position that the use of the phrase "consisting essentially of" does not rule out the presence of BIT, i.e., the essential composition required by the Eggensperger reference. For the reasons provided below, the undersigned respectfully disagrees.

As noted by the Examiner, the case law surrounding "consisting essentially of" provides that the claim is "closed", except for materials that do not materially affect basic and novel characteristics of the claimed composition. However, the case law also provides that once the applicant has shown that a composition has basic and novel properties, as they do here, there is no requirement that the potential additives from prior art compositions be tested to determine whether they affect the basic and novel characteristics of the claimed composition.

For example, in *In re De LaJarte* 143 U.S.P.Q. 256 (1964), which was cited by the Examiner, the applicant claimed a glass composition that excluded the presence of sulfur and carbon via his use of "consisting essentially of" transition. The applicant had provided evidence that his claimed composition had better increase in resistance to perforation, but did not have

evidence regarding whether sulfur or carbon would change the basic and novel characteristics of his claimed glass. In overturning the rejection by the Board and the Examiner, the CCPA stated:

"The solicitor would put the burden of showing a material change on the appellant. . . [H]ere appellant has the burden of showing the basic or novel characteristics of his insulating glass. He has met his burden by pointing out in his specification and claims the great increase in resistance to perforation resulting from his composition.

The Board of Appeals and the solicitor contend that appellant has furnished no evidence that a critical difference in appellant's emphasized characteristics would result from the introduction of small amounts of Lyle's coloring agents, charcoal and sulfur. It is not clear what evidence they would require. The solicitor has noted that an affidavit which the board did not consider contains nothing significant on this issue. It may be implied that the Patent Office would require appellant to duplicate the Lyle glass and compare its resistance to perforation with that of appellant's glass.

In the total absence of evidence in the record to indicate that the amber glass disclosed by Lyle would be expected to have desirable electrical insulating properties, we can find no justification for placing the burden on applicant to conduct experiments to determine the insulating properties of the colored glass disclosed by Lyle. Although there are only very slight differences between the Lyle composition and that sought to be patented, we cannot assume that these small differences are incapable of causing a difference in properties. Appellant, in showing that his glass has basic and novel properties (at least as far as the record is concerned), would appear to have met his burden." (emphasis added).

Similar circumstances exist here.

The present application illustrates that the claimed composition is especially useful in destroying and inactivating viruses. As described in PARA. 0046-0049 of the application, when the claimed solution is "suitably buffered", the claimed long-chained alkyl triamine forms a cationic species. Together with the claimed amphoteric surfactant, the triamine appears to attack the outer wall of the capsid of the virus. (PARA. 0048) In other instances, the buffered cationic triamine may bond to the outer surfaces of the virus, preventing replication. (PARA. 0049) The claimed triamine and/or amphoteric surfactant also may bind to critical parts of the DNA/RNA, resulting in an inability of the virus to replicate. (PARA. 0048) The claimed iodine and/or aliphatic alcohol of the claimed solution may complex with the DNA and/or RNA of the viruses.

(PARA. 0048) The results provided in PARA. 0053-0058 and illustrated in FIG. 1 show the efficacy of the claimed composition in destroying viruses. Therefore, as in *In re De LaJarte*, applicants have shown that the presently claimed composition provides basic and novel properties in destroying viruses.

Neither of the cited prior art documents show an effectiveness at destroying viruses -- both specifically refer to microbes (i.e., bacteria) and only bacteria are referenced in the examples of the prior art (see, Eggensperger, Col. 1, lines 54-61 and the examples of Cols. 4-5). Furthermore, it is unclear at this time how BIT would affect the basic and novel properties of the presently claimed solution in destroying viruses. It is quite possible that the presence of BIT would materially and detrimentally affect the buffering of the triamine solution, the ionization of the triamine compound and/or the effectiveness of other constituents of the claimed composition to adequately attack viruses. However, applicants are not required to test such a composition in view of *In re DeLajarte*, and in view of the fact that the presently claimed composition has been shown to have basic and novel properties, the claims are allowable in view of *In re DeLajarte*.

IV. Conclusion

Having responded to all rejections set forth in the outstanding Office Action, it is submitted that all pending claims are in condition for allowance, and notice to that effect is respectfully solicited.

Respectfully submitted,



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